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a marker comprising a disk that is free of an appendage and having a solid face with an image at least partially covering a central portion and being removably attached to a clip;

one of said clip and said marker having a ferrous portion;

an other of said clip and said marker having a magnetic portion; and

said clip being free of golf tee attachment surfaces and being clipped to a shoe.

Please cancel claims 11 and 12, without prejudice.

Remarks

Reconsideration of the present application is respectfully requested.

This response is accompanied by a petition for a three (3) month extension of time, and a check in the amount of \$460.00 to cover the extension of time fee. The Assistant Commissioner is authorized to charge any underpayment or credit any over payment to deposit account number 500226.

Claims 1-3, 6-8, 11 and 12 stand rejected under 35 USC §103(a) over Hoyt et al. in view of Giglio. Claims 4, 5, 9 and 10 are further rejected in view of Kennedy. Applicant respectfully disagrees, because Hoyt et al. does not show what the Office Action asserts. In particular, the office action asserts that Hoyt shows a holding system in which a marker is removably attached to a clip. Instead, Hoyt et al. shows, and does not suggest to the contrary, a ball marker that is attachable to a divot repair tool via a post 28 that is received in a bore 26. The divot tool itself is capable of being carried by a separate clip member 20. Therefore, if one were to combine the magnetic teachings of Giglio with the teachings of

Hoyt et al., one would arrive at something other than what Applicant has claimed. In particular, one would arrive at a divot repair tool with a magnetically attached ball marker, which is different than the subject matter claimed by Applicant.

Although Applicant respectfully asserts that the cited references cannot be properly combined to create a proper §103(a) rejection against Applicant's claims, Applicant has amended independent claims 1 and 6 in a way that better distinguishes the claimed subject matter from the contents of the cited references. In particular, claims 1 and 6 have been amended to make it clear that Applicant's clip is free of golf tee attachment surfaces. Both of the cited references teach multifunction accessories, and hence lack Applicant's insight that issues relating to storage and usage of a ball marker are best kept separate from issues relating to golf tees, divot repair tools, and the like.

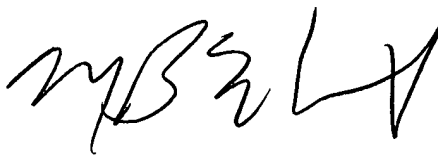
Applicant has also amended independent claims 1 and 6 in a way that makes it clear that the ball marker comprises a disk that is free of appendages of the type shown in Hoyt et al. Since Hoyt et al. teaches away from a ball marker having a configuration of the type now claimed by Applicant, the cited references cannot be properly combined to arrive at Applicant's claimed invention, even ignoring the fact that Hoyt et al.'s ball marker is not even attached to its clip. Therefore, because the cited references teach away from at least one feature of the claimed invention, and because they cannot properly be combined to arrive at Applicant's claimed invention, Applicant respectfully requests that the outstanding §103 rejections be withdrawn.

Over and above the reasons set forth above, included herewith is evidence of patentability that Applicant's invention satisfied a long felt need among golfers for a simple and effective solution to problems

associated with storage and usage of a ball marker. When the verified testimonials of the tour golf players are considered in conjunction with the claim amendments and arguments, the outstanding §103(a) rejections should, in all fairness, be withdrawn.

In view of the amending changes made, and arguments submitted, this application is believed to be in condition for allowance of claims 1-10, however, if the examiner believes that some minor additional clarification would put this application in even better condition for allowance, he is invited to contact the undersigned attorney at (812) 333-5355 in order to hasten the prosecution of this application.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read 'MB McNeil', with a stylized flourish at the end.

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Reg. No. 35,949

Marked-Up Amended Claims

1. A golf ball marker and holder comprising:
a clip that is free of golf tee attachment surfaces and being sized for attachment to a shoe;
a marker comprising a disk that is free of an appendage and having a solid face with an image at least partially covering a central portion and being removably attached to said clip;
one of said clip and said marker having a ferrous portion; and
an other of said clip and said marker having a magnetic portion.

6. A golf ball marker and shoe comprising:
a marker comprising a disk that is free of an appendage and having a solid face with an image at least partially covering a central portion and being removably attached to a clip;
one of said clip and said marker having a ferrous portion;
an other of said clip and said marker having a magnetic portion; and
said clip being free of golf tee attachment surfaces and being clipped to a shoe.